

REMARKS

In this reissue application, original patent claims 1-15 remain pending. New claims 16-20 were previously added, after which claims 17-20 were cancelled. New claims 21-46 were then added.

Claims 1-16 and 21-46 are pending and stand rejected. None of the claims is amended by this paper.

The remarks presented herein are in response to the non-final office action mailed May 14, 2009.

Claims 1-16 and 21-46 were rejected under 35 USC § 251 on two different grounds: a) broadening outside the two-year period and b) defective declaration. Each basis is addressed separately.

Broadening outside the two-year period

Claims 21-46 were rejected under 35 USC § 251 as being improperly broadened. 35 USC § 251 states that “[n]o reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.” The present application is a reissue of US 5,999,977 (“the ‘977 patent”). Since the ‘977 patent issued December 7, 1999, the two-year statutory period extended through December 7, 2001. The present application was filed on December 7, 2001, which is within the two-year statutory period.

Claims 21-46 were added in an amendment filed August 8, 2007. Examiner argued that since August 8, 2007, falls outside the two-year statutory period, the claims should be rejected under 35 USC § 251 (Detailed Action, page 3). Applicant respectfully traverses.

MPEP § 1412.03(IV) states that a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue application which was filed *within* two years from the grant. Where any intent to broaden is unequivocally indicated in the

reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period (MPEP § 1412.03(IV)). Also, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years (*Id.*).

When the present application was filed on December 7, 2001, it was accompanied by an inventor reissue declaration that stated “This is a broadening reissue...” That statement unequivocally indicated an intent to broaden. Therefore, broadened claims (e.g., claims 21-46) could subsequently be presented in the reissue after the two year period.

Examiner and the undersigned attorney discussed this rejection and MPEP § 1412.03(IV) over the phone on May 20, 2009, June 9, 2009, and July 9, 2009. On July 9, 2009, Examiner stated that the inventor reissue declaration that was filed on December 7, 2001 did unequivocally indicate an intent to broaden and that he would withdraw the “improper broadening” rejection of claims 21-46.

Defective declaration

Claims 1-16 and 21-46 were rejected under 35 USC § 251 as being based upon a defective reissue declaration. Examiner argued that none of the errors which are relied upon to support the reissue application is an error upon which a reissue can be based, citing 37 CFR § 1.175(a)(1) and MPEP § 1414 (Detailed Action, page 3). MPEP § 1414 states that a reissue oath or declaration must contain a statement of at least one error which is relied upon to support the reissue application (i.e., as the basis for the reissue). This requirement is explained in MPEP § 1414(II), which is discussed below.

Examiner applied two different grounds for this rejection: a) stated error is inadequate under 35 USC § 251 (claims 1-16) and b) no stated error at all (claims 21-46). Applicant respectfully traverses. Each basis is addressed separately.

Claims 1-16 – stated error is inadequate

On June 13, 2005, an Ex Parte Quayle office action was mailed that rejected claims 1-20 under 35 USC § 251 as being based upon a defective reissue declaration (Detailed Action, page 4). The action stated that receipt of an appropriate supplemental oath/declaration would overcome the rejection (Detailed Action, p. 4).

On July 6, 2005, an inventor reissue declaration was filed that stated “At least one error being relied upon as the basis for reissue is the failure to claim or further claim subject matter disclosed in the specification pertaining to terminating transmission if a predetermined condition in an acknowledgement message is met.” This language was suggested by Examiner Bunjob Jaroenchonwanit in the Ex Parte Quayle action discussed above.

The phrase “terminating transmission if a predetermined condition in an acknowledgement message is met” refers to claim 16, which recited (and still recites) “terminating said broadcast of said data and said multicast communication channel if a predetermined condition regarding said acknowledgement messages from said plurality of second endpoints is satisfied.” Claim 16, which is not present in the ‘977 patent (the patent being reissued), was added when the present application was filed. A change or departure from the original claims represents an “error” in the original patent under 35 USC § 251 (MPEP § 1414(II)(A)). Thus, the failure to include claim 16 in the ‘977 patent represents an error under 35 USC § 251.

In the present office action, Examiner Lin argued that this stated error was not an error upon which a reissue could be based because “terminating transmission if a predetermined

condition in an acknowledgement message is met” was claimed and issued in at least original claims 1 and 9 (Detailed Action, p. 2). Applicant respectfully disagrees.

Whether or not the ‘977 patent includes claims that pertain to “terminating transmission if a predetermined condition in an acknowledgement message is met” is irrelevant. The declaration filed July 6, 2005 stated that an error being relied upon is “the failure to claim or further claim subject matter disclosed in the specification pertaining to terminating transmission if a predetermined condition in an acknowledgement message is met” (emphasis added). The present application, by including claim 16, further claims subject matter disclosed in the specification pertaining to terminating transmission if a predetermined condition in an acknowledgement message is met.

Thus, the error stated in the declaration filed July 6, 2005 is adequate under 35 USC § 251.

MPEP § 1402 discusses grounds for filing a reissue application that may constitute the “error” required by 35 USC § 251 (MPEP § 1414(II)(A)). If Examiner Lin maintains this rejection with respect to the declaration filed July 6, 2005, Applicant requests that he cite the appropriate section of MPEP § 1402 that supports his argument. As a result, claims 1-16 should not be rejected under 35 USC § 251 as being based on a defective declaration.

Claims 21-46 – no stated error at all

Examiner argued that the subject matter recited by claims 21-46 was not related to any of the errors that were stated in any of the declarations that have been filed in the present application (Detailed Action, p. 2). Even if this statement were true, it is not a basis for rejecting claims 21-46 as being based on a defective declaration.

Applicant need specify in the reissue oath/declaration only one of the errors upon which reissue is based (MPEP § 1414(II)(B)). Where Applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied (MPEP § 1414(II)(B)).

As explained above, the error stated in the declaration filed July 6, 2005 is adequate under 35 USC § 251. Therefore, Applicant has met the requirement of specifying one error. As a result, claims 21-46 should not be rejected under 35 USC § 251 as being based on a defective declaration.

Examiner is invited to contact the undersigned in order to advance the prosecution of this application.

Respectfully submitted,
Guy G. Riddle

Dated: July 28, 2009

By: /Sabra-Anne R. Truesdale/
Sabra-Anne R. Truesdale
Reg. No. 55,687
Fenwick & West LLP
801 California Street
Mountain View, CA 94306
Phone (650) 335-7187
Fax (650) 938-5200